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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/655,252	09/05/2000	Lee Cannon	100-114P2	7732

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EXAMINER	
COBURN, CORBETT B	
ART UNIT	**PAPER NUMBER**
3714	

DATE MAILED: 11/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/655,252	CANNON ET AL.	
	Examiner	Art Unit	
	Corbett B. Coburn	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 July 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *48-50,53-55,57-88 and 90-126* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *48-50,53-55,57-88 and 90-126* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *15 January 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 53 & 86 are rejected under 35 U.S.C. 112, first paragraph, because the specification, cannot, by definition, be enabling for dispensing a ticket for a predetermined non-winning outcome. By definition, if a prize (i.e., a ticket) is dispensed, then the outcome is a winning outcome. It may be that the value of the prize is less than other prizes, but the player still wins a prize. Furthermore, since the ticket is dispensed in response to the occurrence of a predetermined game outcome, the ticket is by definition a gaming award. Thus claims 53 & 86 contradict the limitation in the corresponding independent claims that requires the ticket not to be a gaming award.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 53 & 86 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As pointed out immediately above, the claim has a limitation that directly contradicts a limitation in the independent claims. Examiner cannot determine the meaning of the claims and therefore cannot apply art to the claims.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 48-50, 54, 55, 59-63, 78-84, 92-97 & 111-122 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly et al. (US Patent Number 5,816,918) in view of Deaton et al. (US Patent Number 5,621,812).

Claims 48, 84: Kelly teaches a gaming device (10) with a currency receiver (14) being adapted to receive at least one medium of currency and a display device (56) being adapted to display indicia corresponding to an outcome of a wagering game (i.e., poker, blackjack, solitaire – Col 1, 28-29). The outcome of an occurrence of the wagering game is at least partially randomly determined. There is a first output device (20) adapted to dispense a gaming award based on the occurrence of a predetermined winning outcome during the occurrence of the wagering game after depositing at least a minimum amount of the at least one medium of currency in the currency receiver (Abstract). There is a second output device (22) being adapted to dispense a ticket after the occurrence of a triggering event. The ticket might be a promotional coupon that can encourage the player to return to the current gaming location in the future. (Col 8, 61-63) The ticket is referred to as a prize, however, and may be considered to be a gaming award.

Deaton teaches a device for providing a ticket to a patron to reward frequent customers or to encourage infrequent customers to become frequent customers. Deaton discloses issuing coupons base on the customer's history of shopping with the establishment and not as a gaming award. Deaton's triggering event is not the occurrence of a predetermined winning outcome of a wagering game or the cumulative result of a plurality of outcomes. Deaton does not award a coupon for every transaction. Deaton makes it clear that the coupons are awarded based on the customer's history of shopping in the establishment. (Figs 17A & B)

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kelly in view of Deaton to issue tickets that are not a gaming award upon the occurrence of a triggering event that is not the occurrence of a predetermined winning outcome of a wagering game or the cumulative result of a plurality of outcomes or every transaction (i.e., every occurrence of the wagering game) in order to encourage the player to return to the current gaming location in the future.

Claim 49: Kelly teaches that the system may be applied to slot machines. (Col 3, 44) Slot machines have at least one reel display.

Claim 50: Kelly's Fig 2 clearly shows that display device (56) is a video display.

Claims 54, 55, 87 & 88: Deaton teaches that the triggering event is based on the customer's history of shopping in an establishment. (Figs 17A & B) This includes frequency of shopping (which corresponds to a predetermined number of non-winning outcomes) and frequency of shopping within a period of time (corresponding to a predetermined number of non-winning outcomes in a certain time period).

Claims 59, 92, 93: Kelly teaches the use of smart cards and user validation/verification. (Col 6, 46-56) This is equivalent to a user-tracking card.

Claims 60, 94: Kelly teaches the tickets dispensed by the output device may be promotional tickets. (Col 8, 61-63) Deaton also teaches promotional tickets (coupons).

Claims 61, 95: Kelly teaches the tickets dispensed by the second output device may be redeemable for one occurrence of the wagering game. (Col 8, 60)

Claims 62, 96: Kelly teaches that prizes are "any merchandise, souvenir, food item, or other physical goods or services which can be offered to players". (Col 8, 55-56) Kelly specifically teaches that a free game is a prize. (Col 8, 60) An occurrence of a second wagering game on a second gaming device is a service that can be offered to players. Therefore, Kelly teaches the tickets dispensed by the second output device may be redeemable for one occurrence of a second wagering game on a second gaming device.

Claims 63, 97: Kelly teaches that prizes are "any merchandise, souvenir, food item, or other physical goods or services which can be offered to players". (Col 8, 55-56) Thus, the tickets dispensed by the second output device are redeemable for services provided by a gaming establishment.

Claims 78, 111: Kelly teaches that the tickets are redeemable for prizes. Thus, the tickets are different in form from the gaming award. Furthermore, Kelly teaches that the game award may take the form of cash issued by the machine. (Col 8, 7-9) This is different in form than the tickets issued.

Claim 79: The first output device comprises a printer. (Col 10, 30-35)

Claims 80, 112: Fig 2 shows the printer prints indicia corresponding to at least one of a plurality of signals generated at a location remote from the gaming device. In this case, the printer (50) is remote from the game device (10).

Claims 81, 113: The plurality of signals are generated by a gaming establishment. The game machine (10) generates the signals and it belongs to a gaming establishment.

Claims 82, 83, 114, 115: Kelly teaches the plurality of signals are generated in direct response to operator input -- operation of the "Collect Prize" button (286) by the player.

Claim 116: Kelly teaches providing a player with an opportunity to place a wager and to play the wagering game at the wagering device, wherein the outcome of each occurrence of the wagering game is at least partially randomly determined. (Abstract) Kelly teaches accumulating points for the player as the player plays the wagering game and displaying a visible indication (125) of the player's accumulated points at the gaming device and providing the player with the opportunity to redeem at least a portion of the accumulated points at the gaming device via an input device. (Abstract) Kelly also teaches that the gaming device may be used for promotional uses – i.e., comps. (Col 6, 61-63) In that situation, the points accumulated by the player would be comp points. Deaton also teaches awarding comps (i.e., discount coupons) based on the frequency of visits by a patron. These comp points are independent of the outcome of the randomly determined wagering game or by skill of the player. Deaton teaches that this helps increase the frequency of customer visits, thus increasing profits. (Col 64, 39 – Col 67, 30) It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kelly in view of Deaton to award comp points that are not determined by the

outcome of the randomly determined wagering game or by skill of the player in order to increase the frequency of customer visits, thus increasing profits.

Claims 117, 121: Kelly teaches displaying at least one redemption option to a player at the gaming device. (Fig 6b)

Claim 118: Fig 6b shows highlighting one of the prizes and checking a box. This is changing the display of the at least one redemption option of the gaming device.

Claim 119: A player has to provide input in order to play the game and accumulate comp points. Thus player input at the gaming device is required prior to displaying the player's accumulated comp points.

Claim 120: In order to redeem points, the player must provide input to make a selection of the prize. (Fig 6b)

Claim 122: Kelly teaches printing tickets redeemable for goods and services. (Col 8, 55-56)

7. Claims 57, 58, 90 & 91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly and Deaton as applied to claim 48 or 84 above, and further in view of Harlick (US Patent Number 5,941,773).

Claims 57, 58, 90 & 91: Kelly and Deaton teach the invention substantially as claimed but do not teach the triggering event being a randomly determined occurrence of a wagering game or a randomly determined time. Harlick teaches awarding a bonus based on a randomly determined occurrence of a wagering game (Fig 2) or a randomly determined time (Fig 3). Harlick teaches that this scheme will induce players to play the games. (Col 1, 9-10) It would have been obvious to one of ordinary skill in the art at the

time of the invention to have modified Kelly and Deaton the triggering event be a randomly determined occurrence of a wagering game or a randomly determined time in order to induce players to play the game.

8. Claims 64, 98 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly and Deaton as applied to claim 48, 84 above, and further in view of Harrison (US Patent Number 5,934,671).

Claims 64, 98: Kelly and Deaton teach the invention substantially as claimed but do not teach the award of scratch-off tickets. Harrison teaches scratch-off tickets. Scratch-off tickets are well known to the art and are often used as promotional tickets. Having a scratch-off ticket prolongs the player interest in the game because it adds another step to the game. It would have been obvious to one of ordinary skill in the art at the time of the invention to have issued Kelly's and Deaton's promotional tickets in the form of Harrison's scratch-off ticket in order to prolong the player interest in the game by adding another step to the game.

9. Claims 65, 66, 99 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly and Deaton as applied to claim 48 above, and further in view of Baerlocher et al. (US Patent number 5,788,573).

Claims 65, 66, 99: Kelly and Deaton teach the invention substantially as claimed, but do not teach a secondary gaming unit with a wheel to display randomly generated indicia and a gaming award dispensed upon occurrence of a winning secondary outcome. Baerlocher teaches use of a secondary gaming unit in the form of a wheel to display randomly generated indicia and a gaming award dispensed upon occurrence of a winning

secondary outcome. (Fig 4) Bonus games are well known to the art and are known to attract players. It would have been obvious to one of ordinary skill in the art to have modified Kelly and Deaton in view of Baerlocher to have a secondary display in the form of a wheel to display randomly generated indicia and a gaming award dispensed upon occurrence of a winning secondary outcome in order to provide a bonus game that attracts players.

10. Claims 67-77, 100-110 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly and Deaton as applied to claim 48 above, and further in view of Mullins (US Patent Number 5,158,293).

Claims 67-70, 100-103: Kelly and Deaton teach the invention substantially as claimed. Kelly teaches dispensing a ticket that can be redeemed for prizes. Kelly teaches that prizes are "any merchandise, souvenir, food item, or other physical goods or services which can be offered to players". (Col 8, 55-56) Kelly also teaches that tickets may be redeemed for a free game. (Col 8, 60) Kelly does not, however, specifically teach that the ticket may also be redeemed for an entry in a drawing, though such a ticket would be within Kelly's definition of a prize. Mullins teaches a lottery ticket that may be used in a drawing. Lotteries are extremely popular with both players and casinos. Players find lotteries exciting for the same reason casinos like them -- lotteries can offer large prizes. However, some players prefer a certain payout since lotteries have such poor odds of winning. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Kelly and Deaton in view of Mullins to dispense tickets be redeemable for one occurrence of the wagering game and entries in a drawing in order to

take advantage of the popularity of lotteries while, at the same time giving the player a certain payout in the form of a free game.

Claims 71, 74, 104: Mullins teaches an embodiment with means for receiving a player's selection of at least one indicia from a predetermined set of indicia for the drawing. (Col 5, 12-15)

Claims 72, 105: Mullins teaches randomly selecting the indicia. (Col 3, 59-61) The indicia are randomly assigned to the user, therefore the gaming unit selects the indicia.

Claims 73, 106: Mullins teaches that the indicia are numbers. (Col 3, 59-61)

Claims 75, 108: Mullins teaches allowing the player to choose indicia for a drawing-type lottery. (Col 5, 12-15) Mullins is silent concerning how these indicia are entered into the device. Keypads are well-known devices for data entry. Kelly teaches a keyboard input device. (Col 7, 4-9) A keyboard is a keypad.

Claims 76, 109: Kelly teaches a touch screen input device. (Col 7, 7)

Claims 77, 110: Mullins teaches that the indicia are numbers. (Fig 5)

11. Claims 123-126 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly and Deaton as applied to claim 116 above, and further in view of Boushy (US Patent Number 5,761,647).

Claims 123-126: Kelly and Deaton teach the invention substantially as claimed. Kelly teaches allowing the player to accumulate comp points, but does not go into the details. Boushy teaches accumulating a plurality of comp values according to different comp criteria. (Col 5, 16-19) The comp values have corresponding comp awards. (I.e., The

player gets more points for certain activities.) The player may continue to accumulate points even after the player has reached a comp value level that qualifies for an award.

All activities that are eligible for "comping" get an award of comp points for the player. As pointed out at Boushy's Col 5, 16-19, some activities earn a larger award than others. Whenever a player participates in any of these activities, the player receives comp points – even if the player has already had an award of comp points.

"Comping" is well known to the art. It is a method of attracting repeat players and for awarding players non-monetary awards -- both of which increase casino profits. It would have been obvious to one of ordinary skill in the art at the time of the invention to have taken Kelly's suggestion of awarding comps and fleshed it out using Boushy's disclosure in order to have a complete comping system that attracts repeat players and for awards players non-monetary awards, thus increasing casino profits.

Double Patenting

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 48-50, 53-55, 57-88 & 90-126 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-48 of

copending Application No. 10/353,689. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both claims a wagering game that dispenses tickets based on the same criteria.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

14. Applicant's arguments filed 12 July 2004 have been fully considered but they are not persuasive.

15. Applicant argues that the combination of Kelly and Deaton fail to teach the dispensing of a ticket that is not a gaming award from a gaming unit and that even if they did, there would be no motivation to combine the references. Examiner disagrees.

As pointed out above, Kelly teaches the award of comps from a gaming machine. Comps are a device by which the casino attempts to build and maintain customer loyalty by providing discounts on goods and services offered by the casino. Comps are exceedingly well known in the gaming industry. While Examiner does not believe that Kelly awards the comps as a gaming award, there is room for reasonable doubt. At any rate, Kelly clearly teaches awarding a coupon to encourage continued customer loyalty. (Col 8, 61-63)

Deaton is another invention concerned with building and maintaining customer loyalty. Deaton also dispenses a ticket at the point of sale (analogous to the gaming machine). This ticket is dispensed in response to an event other than receipt of a wager – the determining factor is the generation of a random number or the determination that the customer meets certain criteria regarding frequency of shopping. The latter factor is identical to that used by casinos to

determine when to award comps. Deaton dispenses a ticket that provides a discount on goods and services offered by the business using Deaton's device. This is exactly identical to Kelly's comps coupon. Thus the combination of Kelly and Deaton would teach Applicant's invention.

As to motivation to combine, Applicant is suggesting that there would be no motivation to combine a device that provides a coupon for goods and services offered by an establishment in order to build and maintain customer loyalty with another device that provides a coupon for goods and services offered by an establishment in order to build and maintain customer loyalty merely because one of the establishments is a casino and the other is disclosed to be a grocery store. Clearly, however, the two inventions address the same problem – how to build and maintain customer loyalty. Furthermore, there is conceptually no difference between a casino and a grocery store – they both sell goods and services to the public. Therefore the inventions are analogous art.

Applicant argues that the prior art must suggest the reason to combine. Deaton provides just such a suggestion. Deaton teaches that use of the Deaton method of coupon distribution will result in increased customer loyalty. This translates to more business and more money for the business adopting Deaton's invention. This is powerful motivation to adopt the invention – especially when Kelly teaches that the matter is one that concerns the casino owner.

Conclusion

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (571) 272-4447. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cbc

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